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10/813,604	03/31/2004	Thomas Palmieri	2006P26237 US	4357

  

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EXAMINER	
WRIGHT, PATRICIA KATHRYN	

  

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1797	

  

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1-22-09  
In re Application of : DECISION ON  
Palmieri et al. : PETITION  
Serial No.10/813,604 :  
Filed: March 31, 2004 :  
For: MUTLIPATH ACCESS SYSTEM FOR USE IN AN :  
AUTOMATED IMMUNOASSAY ANALYZER :

This is a decision on the PETITION UNDER 37 CFR 1.44 TO WITHDRAW THE RESTRICTION REQUIREMENT filed September 04, 2008.

On June 04, 2008, a three way restriction requirement by original presentation was made by the examiner in the FINAL rejection. The examiner took the position that two of the groups were related as combination /subcombinations and that the third group was related to the other groups as a process and apparatus for its practice. Applicants traversed the restriction requirement in a response filed August 04, 2008. The examiner maintained the restriction requirement in the Advisory Action mailed August 11, 2008.

On September 04, 2008, the instant petition under 37 CFR 1.144 was filed to formally request the withdrawal of the restriction requirement.

Applicant's position for the withdrawal of the restriction requirement is that the examiner has not grouped the claims properly as combination/subcombination and has not shown the separate groups are distinct.

## DECISION

Sections 803 and 806.05(c) of the MPEP state:

### *803 Restriction - When Proper*

*Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - §*

### *806.05(c) Criteria of Distinctness for Combination, Subcombination, or Element of a Combination*

*In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated.*

*To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search.*

*See MPEP § 808.02.*

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*The inventions are distinct if it can be shown that a combination as claimed:*

*(A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and*

*(B) the subcombination can be shown to have utility either by itself or in other and different relations.*

*When these factors cannot be shown, such inventions are not distinct.*

**806.05(e) Process and Apparatus for Its Practice — Distinctness**

*In applications claiming inventions in different statutory categories, only one-way distinctness is generally needed to support a restriction requirement. See MPEP § 806.05(c).*

*Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process as claimed can be practiced by another materially different apparatus or by hand; or (B) that the apparatus as claimed can be used to practice another and materially different process.*

*If the apparatus claims include a claim to "means" for practicing the process, the claim is a linking claim and must be examined with the elected invention. If it is ultimately allowed, rejoinder is required. See MPEP § 809.04.*

In the restriction requirement mailed June 04, 2008, the examiner required restriction between I) claims 27-38 drawn to a multi path access system II) claims 39-46 drawn to multi path access system, and III) claims 47 to a method of moving samples. The examiner stated that the groups are distinct for the following that Group I and II are related as combination-subcombination and that the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require a transfer shuttle, positioned to slide in a direction perpendicular to a portion of the transporter device, for moving vessels to and from the vessels holders. The subcombination has separate utility such as means mix the sample in vessels. The examiner further stated Groups (I or II) and III are related as apparatus and process and that the apparatus of Groups I and II, as claimed can be used to practice another and materially different process which does not require the step of optimizing the path for each sample such that samples having identical resource requirements travel an equal distance around the first continuous loop as required in Group III.

The Applicants in the response filed August 04, 2008 argued that the groups are not distinct and that the examiner has failed to disclose such distinctness. The Applicants argued that Group I and Group II are not related as combination-subcombination in that all the particulars of Group I are found in Group II. The Applicants further argued that the Groups III and I and II are not distinct related process and apparatus in that MPEP §806.05(3) explains, "[t]he burden is on the examiner to provide reasonable examples that recite material differences." The assertion fails to state a material difference between the method as set forth and the process as allegedly capable of being carried out by the claimed apparatus.

In response to applicants arguments, the examiner in the office action mailed August 11, 2008 stated that the restriction requirement would be maintained as that claim 39 does not set forth all

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the same components as claim 27. As pointed out in item 4 of the Final action (6/4/2008), claim 39 includes a transfer shuttle positioned to slide in a direction perpendicular to a portion of the transporter device which not required by claim 27. Similarly, the restriction from Groups I and II do provide a reasonable example as to how these Group can be used to practice another materially different process, i.e., these apparatus do not require the step of optimizing the path for each sample, as discussed in item 3 of the Final.

Applicants in response filed the instant Petition. Applicants argued again that the Groups are not related as subcombination-combination nor are they distinct process and apparatus for its practice.

First it is noted that Claim 27 is written in means plus function terminology "means for moving ...". and that the examiner has failed to present an analysis of the claims under 112 6<sup>th</sup> paragraph. As proper under MPEP 2181 112 6<sup>th</sup> paragraph analysis, a means plus function recitation is interpreted as being the structure disclosed in the specification or an obvious equivalent thereof. Looking to the specification it is clear such means for moving is the same as the transfer shuttle recited in claim 39, see specification page 4 lines 23-25. Thus since the claim 27 require all the particulars of claim 39 the Groups I and II are clearly not a distinct combination-subcombination.

Applicants arguments at page 3 of the instant petition regarding the distinctness of Group III and Groups I or II is persuasive in that it is clear that the examiner has not met the burden of showing examples that recite material differences.

Accordingly, the petition for withdrawal of the restriction requirement is **GRANTED**.

The application is being forwarded to the examiner to examine all of the pending claims and issue a new non-final office action accordingly.

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